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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Starcrest Products of California, Inc.

Serial No. 76307697

Glenn S. Bacal and Christine Meis of Quarles & Brady
Streich Lang for applicant.

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Office 106 (Mary I. Sparrow, Managing Attorney).

Before Hanak, Quinn and Bottorff, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

Starcrest Products of California, Inc. filed an
application to register the mark LEISURE LIVING for "mail
order catalog and mail order services in the field of
general merchandise, in the area of tools, gadgets, sprays,
solutions and other things for making one's home chores
inside and outside the home easier, and excluding swimming
pools, swimming pool supplies, swimming pool equipment,

outdoor furniture, swimming pool accessories, fencing, swim masks and swimming pool fins, toys, games and floats."¹

The trademark examining attorney refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, when used in connection with applicant's services, so resembles the previously registered mark LEISURE LIVING STORES ("STORES" disclaimed) for "retail stores and mail order and telephone order catalog services featuring swimming pools, swimming pool supplies, equipment and accessories, outdoor furniture, fencing, swim masks and fins, toys, games and floats"² as to be likely to cause confusion.

When the refusal to register was made final, applicant appealed. Applicant and the examining attorney filed briefs. An oral hearing was not requested.

Applicant argues that its services are very different from those identified in the cited registration. Applicant contends that registrant's services feature only products related to pools, and that such products have been explicitly excluded from the items featured for sale through applicant's services. The products sold via

¹ Application Serial No. 76307697, filed August 31, 2001, alleging first use anywhere and first use in commerce on August 18, 1994.

² Registration No. 2021608, issued December 10, 1996; Section 8 affidavit accepted, and Section 15 affidavit acknowledged.

applicant's and registrant's services have, according to applicant, different functions and physical characteristics. Applicant argues that "tools, gadgets and other items associated with chores provide a completely different function from recreation--that of physical labor" and that "the whole theme of swimming pool recreation is different than and separate from that of Applicant's." (Brief, p. 6). Applicant further points out that, unlike registrant, it does not offer retail store services and that "[g]iven the great number of catalogs available to consumers, consumers have learned to distinguish retail stores with catalogs from catalog services offering only catalog and mail order services." (Brief, p. 8). In urging that the refusal be reversed, applicant also highlights the facts that registrant has used its mark for nearly twenty years without expanding into applicant's market, and that the marks have coexisted for over nine years without any instances of actual confusion. In support of its position, applicant submitted an excerpt of registrant's website retrieved from the Internet.

The examining attorney maintains that the marks are essentially identical and that the services are closely related. The examining attorney asserts that swimming pool supplies, equipment and accessories can be broadly

described as tools, gadgets, and solutions which make one's chores outside of the home easier. The examining attorney also points to the evidence that the same entities sell both pool and gardening equipment and supplies. The absence of actual confusion is not, according to the examining attorney, persuasive in the context of this ex parte proceeding. In support of the refusal, the examining attorney submitted third-party registrations, and excerpts of websites retrieved from the Internet, all offered to show that the same entities sell both swimming pool and garden equipment and supplies.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also: *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also: *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We first turn to compare the marks. The marks are virtually identical in sound, appearance and meaning, with the only difference being the inclusion of the generic term "STORES" in the cited mark. With respect to a comparison of applicant's mark LEISURE LIVING with registrant's mark LEISURE LIVING STORES, we must consider the marks in their entireties. Nevertheless, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided [that] the ultimate conclusion rests on consideration of the marks in their entireties." In re National Data Corp., 753 F.3d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). For example, "that a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark...." Id. at 751.

In the case at hand, when comparing the two typed marks, the generic word "STORES," which has been disclaimed, clearly is subordinate to the remainder of the words, "LEISURE LIVING," in registrant's mark. This dominant portion of registrant's mark is identical to the entirety of applicant's mark. Applicant has merely deleted

the generic word "STORES" from registrant's mark; it hardly need be stated that this deletion does not sufficiently distinguish the marks in any meaningful way. In re El Torito Restaurants Inc., 9 USPQ2d 2002 (TTAB 1988).

Throughout the prosecution of its application, and in its appeal brief, applicant was conspicuously silent as to the duPont factor of the similarity between the marks. It was not until its reply brief that applicant made an argument that the marks "create different commercial impressions." (Reply Brief, p. 3). Applicant contends that the presence of "STORES" in registrant's mark makes the two marks sufficiently different in commercial impressions. According to applicant, "'Stores' creates the commercial impression that the Registrant provides 'retail store services'" whereas "[i]n contrast, the mark LEISURE LIVING does not give that impression, and correctly so, because Applicant does not provide 'retail store services.'" (Reply Brief., p. 4). We are entirely unpersuaded by this argument. What applicant overlooks is that in addition to retail store services, registrant renders mail order and telephone order catalog services. Thus, as used in connection with the respective marks, we

see very little difference in commercial impressions.³

In sum, the marks, in their entireties, are virtually identical in sound, appearance and meaning. Differing in only the generic term "STORES" in registrant's mark, the marks engender virtually identical overall commercial impressions so that, if used in connection with similar services, confusion would be likely to occur among consumers.

We next turn to consider the services. Our likelihood of confusion determination must be made on the basis of the services identified in applicant's application and in the cited registration. In re Elbaum, 211 USPQ 639 (TTAB 1981). As noted above, registrant's identification reads

retail stores and mail order and
telephone order catalog services
featuring swimming pools, swimming pool
supplies, equipment and accessories,
outdoor furniture, fencing, swim masks
and fins, toys, games and floats.

Applicant's services are identified as

mail order catalog and mail order
services in the field of general
merchandise, in the area of tools,
gadgets, sprays, solutions and other
things for making one's home chores
inside and outside the home easier, and
excluding swimming pools, swimming pool

³ As shown by the examining attorney's evidence, entities such as Pottery Barn and Restoration Hardware offer both retail store services and mail order and telephone order catalog services under the same mark.

supplies, swimming pool equipment,
outdoor furniture, swimming pool
accessories, fencing, swim masks and
swimming pool fins, toys, games and
floats.

In comparing the services, it is not necessary that they be identical or even competitive in nature in order to support a finding of likelihood of confusion. It is sufficient that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under circumstances that would give rise, because of the marks used in connection therewith, to the mistaken belief that the services originate from or are in some way associated with the same source. In re International Telephone and Telegraph Corp., 197 USPQ 910 (TTAB 1978).

We find that registrant's and applicant's services are related. Both registrant and applicant render mail order catalog services featuring products that, although not identical or competitive, are sufficiently similar so that when rendered under virtually identical marks consumers are likely to be confused. Applicant's mail order services are broadly worded, featuring the sale of, inter alia, items "in the field of general merchandise" and "other things for making one's home chores inside and outside the home easier." A review of the specimens, taken from applicant's

catalog, shows items such as a garden owl used as an outdoor decorative ornament to ward off birds and rodents, outdoor water hose fittings and an electro-magnetic bug repeller. Even though applicant specifically has excluded the swimming pool equipment, supplies and accessories featured in registrant's services, applicant's mail order services feature "general merchandise" items and "things for making one's home chores outside the home easier." As defined in applicant's recitation of services, some of these products might be used in conjunction with a swimming pool. Taking care of a home swimming pool is certainly a chore, and there are swimming pool products which make the chore easier to complete. There are also products which might be used around a swimming pool. A prime example is the decorative owl that could be placed near a swimming pool and/or outdoor furniture. As shown by the examining attorney's Internet evidence, the same entity may sell both swimming pool items and outdoor/garden items.

Applicant's and registrant's services would be purchased by some of the same classes of purchasers, including homeowners. These purchasers would be expected to exercise nothing more than ordinary care in making their decisions. Further, in making our likelihood of confusion determination, we have kept in mind the normal fallibility

of human memory over time, and the fact that consumers retain a general rather than a specific impression of trademarks encountered in the marketplace.

Other than counsel's unsupported assertion, the record is devoid of any evidence bearing on the lack of actual confusion between the marks over nine years of contemporaneous use. Inasmuch as there is no evidence as to the nature and extent of the use of the respective marks, there is little basis to find that the lack of actual confusion is significant. That is to say, we have no way of knowing whether there has been a meaningful opportunity for confusion among purchasers. Even if there were evidence of the use of the marks, the "lack of evidence of actual confusion carries little weight." In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003).

Decision: The refusal to register is affirmed.